

Remarks/Arguments

This amendment is submitted in response to the final Office Action of January 21, 2004, identified as Paper No. 7. Claims 1-11 remain pending in the application.

Claims 1, 4 and 6 were again rejected under 35 U.S.C. § 102(b) as anticipated by individual packets of salt available in restaurants. Claims 1-11 were rejected under 35 U.S.C. § 103(a) as obvious in light of U.S. Patent No. 4,047,647 to Lewis ("*Lewis*").

With regard to the rejection in light of prior art salt packets, the Examiner has improperly failed to consider the functional limitations to the structural elements recited in the claims. In particular, the Examiner assumed that because the cited prior art contains the structure recited in the claims, it necessarily also includes the functional limitations. This assumption is legally incorrect.

As an initial matter, functional limitations are accepted means for defining the particular capability or purpose that is served by a recited element. MPEP § 2173.05(g). As a result, a functional limitation should be evaluated and considered, like any other limitation, for what it conveys to a person of ordinary skill in the art. *Id.* For example, the limitation that a chemical compound was "incapable of forming a dye with said oxidizing developing agent" was held acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 U.S.P.Q. 33 (CCPA 1971).

The claims here are directed toward a flexible, semi-permeable material or membrane that is capable of releasing an ice melting substance when placed in contact with ice. Thus, the recited element of a flexible, semi-permeable membrane is ***further limited*** to those flexible, semi-permeable membranes that can effectively release a salt compound when encountering ice.

In other words, Applicant has affirmatively set finite boundaries on the recited structure by using functional language as a limitation. *See* MPEP § 2173.05(g).

Although the Examiner raises the argument that the paper envelope that encloses the table salt in the prior art packets may be a flexible, semi-permeable membrane, it does not necessarily follow that the prior art structure also meets the limiting functional language contained in the claims. A limitation, by definition, defines a smaller class than what is encompassed by the claimed element. Thus, the Examiner's statement that "[s]ince all of the structural elements of the noted claims are met by the described prior art, all of the claimed functions . . . are also considered to be met by said prior art" is legally improper and insufficient to anticipate the claimed invention as the functional limitations more narrowly defines the claimed structure.

Applicant has affirmatively limited the flexible, semi-permeable membrane of the present invention to those membranes that will release an enclosed ice melting substance when placed in contact with ice. A paper salt packet, while possibly including a semi-permeable membrane, does not contain every limitation of the claimed invention as required for a rejection under 35 U.S.C. § 102 because it is not capable of performing the recited limitations.

With regard to a salt packet performing the claimed functions, the Examiner merely guessed that a paper salt packet left on the surface of ice would absorb water on the surface of ice and release a solution containing dissolved salt. This speculation is deficient in two regards, as it assumes water will be present on the surface of the ice and that the packet will properly release a salt solution. The present invention involves a material that releases an ice melting substance when encountering ice, not water. Additionally, the paper envelope of a salt packet must be destroyed in order to release the salt/salt solution inside, due to the inherent permeability

of paper and its susceptibility to water degradation. Indeed, no references were cited to establish that a salt packet will operate as claimed and it is doubtful that this is one of the limited circumstances where mere "common knowledge" in the art can be relied on. *See, generally*, MPEP § 2144.03.

These two distinctions are particularly useful for pointing out the novelty of the present invention over prior art, such as paper packets, that are unacceptable because they do not work properly when placed in contact with ice alone or degrade into waste and litter. Although it seems axiomatic that prior art not be anticipatory if it must be destroyed to operate in the manner set forth in the claims, Applicant has amended claims 1 and 7 to recite that the semi-permeable membrane will function as claimed "without degrading" and more particularly point out the claimed invention over the prior art.

With regard to the rejection in view of *Lewis*, the modification or combinations suggested by the Examiner do not include all limitations of the claimed invention as required by an obviousness rejection. MPEP § 2143.03 ("to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art"). As explained above, the present claims call for a flexible, semi-permeable membrane that will release an ice-melting substance in response to contact with ice. While it may be known in the art to package food items in various containers, as correctly noted by the Examiner, this suggestion in the art is insufficient to motivate the formation of all of the elements of the claimed invention as required for a rejection under 35 U.S.C. § 103. In particular, the Examiner failed to identify any prior art disclosing a semi-permeable membrane that will release the ice melting substance when contacting ice and did not identify a motivation to combine such a teaching to include the other limitations found in claims 1-11.

In view of the foregoing amendments, the Examiner's reconsideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, he is respectfully requested to contact him at (315) 218-8515.

Respectfully submitted,

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